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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,730	10/11/2001	Juha Telimaa	214910US6	6056
22850	7590	10/18/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			GORDON, BRIAN R	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,730

Applicant(s)

TELIMAA ET AL.

Examiner

Brian R. Gordon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8-6-04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10-11-01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the calibration mechanism connected to the fine adjustment retainer" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Interpretations

2. Claim 1 is interpreted as requiring a first and second retainers including respectively first and second threading and a calibration mechanism wherein the pitch of the second threading is less than that of the first threading. It appears as if applicant is attempting to limit the retainer mechanisms as comprising only threading; however, the threading alone does not function to retain the movement of the piston. As disclosed by applicant and as previously indicated by reference elements incorporated in the original claims it is a collection of elements that provide the function or retaining and limiting the motion of the piston. The threading of the shaft is actually threaded or in correspondence with a second element which together functions to retain the movement of the device. It is unclear what applicant intends to be the calibration mechanism for the purpose of examination the examiner is assuming the element is a device such as a sleeve or nut.

Claim Objections

3. Claims 5 and 9 are objected to because of the following informalities: the claims are duplicate claims. Appropriate correction is required.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no basis for the first and second threading alone being defined as and function as retainers of the movement of the piston.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended the claim to broadly state first and second retainers are comprised of first and second threading respectively. Applicant does not specify where the threading is located. However the specification states that the retainers are actually a combination of threading on the shaft and a second element such as a nut. As such, it is suggest applicant claim both threading on the shaft and a corresponding elements (nuts/sleeves) to accurately depict the actual invention. Threading of the shaft or nuts alone does not function to limit the movement of the piston or define limits.

As to the calibration mechanism it appears as if applicant intends for the element to be a separate element from the retainer mechanism. Previously claim 10 recited the calibration element, defined by elements 10 and 11, as being connected to a nut. The specification does not define what elements make up the calibration mechanism nor do the figures show a calibration mechanism. The specification on page 4, recites the calibration element can be connected to the fine adjustment retainer. This is unclear for it is uncertain if the calibration mechanism is an element outside (separate from) the pipette or included within the pipette. What specific elements make up or applicant considers as the calibration mechanism?

As to claim 3 it is unclear how the first threading is disposed between a shaft and a nut. A more accurate description (of the first retainer itself, which should be incorporated in claim 1) would be the first threading is on a shaft and in corresponding contact with the threading of a nut.

Claim 4, makes reference to "the first adjustment threading"; there is no antecedent basis within claims 4 or 3 for such a term.

Claims 5, 6, 9, and 10 makes reference to "the second adjustment threading", there is no antecedent basis within claims such a term.

As to claims 5 and 9, the threading alone of the nut does not accurately define the retainer. It should be claimed similarly to that as suggest above in reference to claim 4.

As to claim 15, the claim states the threading is less than equal to one revolution. One revolution of what? It is unclear what the one revolution is referring to.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-10 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Tervamaki et al. US 4,466,298.

Tervamaki et al. disclose a pipette which comprises a frame portion (1) shaped as a handle, a cylinder being formed inside the frame portion (1), as well as a piston (5) fitted into the cylinder by means of a seal ring (7), a piston rod (4) connected to the piston (3), as well as a press knob (5) with shaft (6), fitted at the upper end of the frame portion (1). Around the shaft (6) of the press knob (5), a calibration sleeve (9) is fitted by means of a threaded joint (8) (second retainer as defining lower limit as required by claims 1-2 and 10), by means of which calibration sleeve (9) (nut as claimed in 5-7, 9-10) the lower limit of the movement of the piston (3) during pipetting can be determined. According to the invention, the calibration sleeve (9), as surrounded by the mantle (10) of the hollow press knob (5) and by the upper part of the pipette frame (1), is placed at a distance both from the mantle (10) of the press knob (5) and from the inner face of the cover of the upper part of the pipette frame (1). Thereby the hollow press knob (5) and the pipette frame (1) form a cover protecting from conducted heat and allow a space of air around the adjustment and calibration sleeve (9) (abstract).

Specifically A sleeve 20 is fitted by means of a threaded joint 21 (first retainer as required in claims 1-4), around the shaft 6 of the press knob. Inside the frame portion 1 of the pipette, there is an annular limiter flange 22, against whose lower face the sleeve 20 (nut) rests by means of its upper face. In this way, the sleeve 20 together with the annular flange 22 determines the upper position of the piston 3.

Above the adjustment thread 21 of the press knob shaft 6, on the press knob shaft 6 there is the calibration thread 8. The diameter and **the pitch** of the calibration thread 8 (second adjustable retainer mechanism) may **be either the same as or different from those of the adjustment thread 21 (including smaller or larger and ranges defined by claims 11-15)**. By means of the calibration thread, a calibration sleeve 9 is fitted around the shaft 6 of the press knob 5, by means of which sleeve 9 the lower limit of the movement of the piston 3 during pipetting can be determined. As surrounded by the mantle 10 of the hollow press knob 5 and by the upper portion of the pipette frame 1, the calibration sleeve 9 is placed at a distance both from the mantle 10 of the press knob 5 and from the inner face of the cover of the upper part of the pipette frame 1. In such a case, the hollow press knob 5 and the pipette frame 1 constitute a protective cover against conducted heat and allow a sufficient air space around the adjustment and calibration sleeve 9. For the secondary movement of the pipette, an annular flange 11 is fitted in the annular space between the calibration sleeve 9 and the pipette frame 1, around the calibration sleeve 9, which annular flange 11 is pressed downwards against a limiter flange 14 placed at the lower portion of the calibration sleeve 9.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tervamaki et al. US 4,466,298.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the pitch of the threading of the device of Tervamaki et al. to include the ranges of adjustment as defined by applicant to ensure that accurate volumes of liquid are sampled precisely to prevent skewed results or improper dosing.

Response to Arguments

13. Applicant's arguments filed August 6, 2004 have been fully considered but they are not persuasive. Applicant argument's as directed to the art rejection appears to be only directed to one issue of Tervamaki not showing a second retainer mechanism a second threading. It appears as if applicant is attempting to state that applicant's invention has two sets of threadings plus a calibration element (claim 1). As pointed out above Tervamaki discloses two threadings (8 and 21) and a calibration element 9 as required by the claims. While it is unclear what exactly applicant considers as the calibration mechanism of the instant invention the examiner asserts the Tervamaki reference meets the limitation of the device as required by the claims.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

brg


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